

PATENT

APPLICATION 10/748,959

ATTORNEY DOCKET 2003-0009 (1014-053)

REMARKS

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

Each of claims 1, 4, 6-10, and 16-20 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Support for the amendments to each of claims 1, 19, and 20 can be found in the specification, as originally submitted, at least at paragraph 62. It is respectfully submitted that no new matter has been added.

Claims 1-20 are now pending in this application. Each of claims 1, 19, and 20 is in independent form.

I. The Objection to the Abstract

The present Office Action objected to the Abstract "because it is written using claim phraseology".

The requirements for an abstract are enumerated in 37 C.F.R. 1.72(b), which states:

[a] brief abstract of the technical disclosure in the specification must commence on a separate sheet, preferably following the claims, under the heading "Abstract" or "Abstract of the Disclosure." The sheet or sheets presenting the abstract may not include other parts of the application or other material. The abstract in an application filed under 35 U.S.C. 111 may not exceed 150 words in length.

Aspirations and/or desires of the USPTO, such as presented in the MPEP regarding what an Abstract "should" comprise, are not legally binding.

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Applicant respectfully submits that the Abstract of the present Application as originally submitted was less than 150 words in length and thus was "brief", pertained to the "technical disclosure", commenced on a separate sheet under the heading "Abstract", and the sheet on which it appeared did not include other parts of the application or other material. Thus, the Abstract of the present Application as originally submitted fully complies with the requirements of 37 C.F.R. 1.72(b). For at least these reasons, Applicant respectfully requests a withdrawal of the objection to the Abstract.

II. The Objection to the Summary

The present Office Action objected to the summary section "because it is written using claim phraseology".

This objection is respectfully traversed.

With all due respect, the MPEP is not the law. Instead, the MPEP merely presents the preferences of the USPTO.

The legal requirements for the content of a patent application are stated in 35 U.S.C. 111 ("such application shall include... a specification"). The legal requirements for the specification are further defined in 35 U.S.C. 112. ("[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.").

Further details regarding the legal requirements for the specification are provided in 37 CFR 1.71 ("The specification must include a written description of the invention or discovery and of the manner and process of making and using the same"; "[t]he specification must set forth the precise invention for which a patent is solicited"; [i]n the case of an improvement, the specification must particularly point out....").

The "Summary of the Invention" is mentioned in the statutory law in 37 CFR 1.73, which states that a "brief summary of the invention indicating its nature and substance... should precede the detailed description." The use of the word "should" rather than the word "must"

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indicates that the Summary section is optional. This interpretation is further supported by the next sentence of 37 CFR 1.73, which states “[s]uch summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.”

Even the USPTO’s interpretation of the law and statement of its preferences, as provided at MPEP section 608.01(d), admits the optional nature of the Summary section via its statement that “[t]he brief summary should be more than a mere statement of the objects of the invention, which statement is also permissible under 37 CFR 1.73.” This permissibility is echoed at MPEP section 608.01(a), which provides a form paragraph stating “[t]he following order or arrangement is **preferred** in framing the specification.... [i]f no text follows the section heading, the phrase ‘Not Applicable’ should follow the section heading....”

For at least these reasons, Applicant respectfully submits that a summary section is not even required and the present Office Action lacks any legal basis whatsoever upon which an objection can be made regarding the present content of the summary section. As a result, Application respectfully declines to amend the summary section.

For at least the reasons mentioned above, it is respectfully submitted that the specification meets all relevant legal requirements, and respectfully requests withdrawal of the objection to the summary section.

III. The Objection to the Title

The present Office Action objected to the title of the present application as allegedly not being descriptive. Applicant respectfully traverses this objection as moot in view of the present amendment to the title of the application. For at least these reasons, withdrawal of the objection to the title is respectfully requested.

IV. The Statutory Double Patenting Rejections

Each of claims 1, 19, and 20 was rejected for double patenting under 35 U.S.C. 101 for claiming the same invention as that of claims 1, 19, and 20 of co-pending Application 10/748,958. The Office Action requires either cancellation of the conflicting claims from all but

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one application or maintenance of a clear line of demarcation between the applications. These rejections are respectfully traversed.

A *prima facie* statutory double patenting rejection requires a showing that rejected claims are drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 14 US PQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

Each of claims 1, 19, and 20 of the present application states, *inter alia*, "codec instructions". By contrast, each of claims 1, 19, and 20 of co-pending Application 10/748,958 states, *inter alia*, "high-quality audio codec instructions". The present application explicitly defines "high quality audio", at paragraph 45, to mean "audio having a maximum frequency greater than 3.5 kHz". Thus, the claimed "codec instructions" of each of claims 1, 19, and 20 are not identical to the "high-quality audio codec instructions" of each of claims 1, 19, and 20 of co-pending Application 10/748,958. As a result, the present Office Action fails to provide a *prima facie* double patenting rejection of claims 1, 19, and 20.

In addition, the rejections are moot in view of the present amendments to each of claims 1, 19, and 20. Each of claims 1, 19, and 20 states, *inter alia*, yet claims 1, 19, and 20 of co-pending Application 10/748,958 do not state, "the subscriber interface line card adapted to support the enhanced mode based on G.722".

For at least these reasons, reconsideration and withdrawal of each rejection of each of claims 1, 19, and 20 under 35 U.S.C. 101 is respectfully requested.

V. The Anticipation Rejections

As an initial matter, Applicant respectfully notes that per MPEP 707.07, a proper Office Action must be complete as to all matters, must provide a clear explanation of all actions taken. The present Office Action fails to meet that requirement. The present Office Action purports, at Page 3, to only reject claims 1, 6, 19, and 20 under 35 U.S.C. 102(b). Yet, at pages 4 and 5 the present Office Action appears to make additional rejections of each of claims 2-5, 7-10, and 15-18 under 35 U.S.C. 102(b). Applicant respectfully submits that this lack of clarity regarding at

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least the rejection of each of claims 2-5, 7-10, and 15-18 means that any future Office Action cannot properly be made final.

Each of claims 1, 6, 19, and 20 was rejected as anticipated under 35 U.S.C. 102(b). In support of the rejection, various portions of WIPO Patent Publication WO 01/17219 A1 ("Hjartarson") were applied. These rejections are respectfully traversed as moot in view of the present amendments to each of independent claims 1, 19, and 20.

Specifically, each of claims 1, 19, and 20, from one of which each of claims 2-10 and 15-18 ultimately depends, states, *inter alia*, yet the applied portions of Hjartarson do not teach, "the line card adapted to utilize an enhanced mode, the enhanced mode adapted to use a codec specified in G.722".

Applicant also notes that establishing *prima facie* case of "[i]nherent anticipation requires that the missing descriptive material is necessarily present, not merely probably or possibly present, in the prior art." *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002); *See also*, MPEP 2112.

Claim 2 states, *inter alia*, yet the applied portions of Hjartarson do not teach, "sampling the received analog signal into a plurality of samples". The present Office Action alleges that this claimed subject matter is inherently present in Hjartarson. To the extent that the present Office Action or future Office Actions rely upon inherency, Applicant respectfully requests provision of a reference demonstrating that the admittedly missing claimed subject matter is "necessarily present, not merely probably or possibly present, in the prior art."

For at least these reasons reconsideration and withdrawal of each rejection of each of claims 1, 19, and 20 is respectfully requested. Also, reconsideration and withdrawal of each rejection of each of claims 2-10 and 15-18, each ultimately depending from independent claim 1, is also respectfully requested.

VI. The Obviousness Rejections

Each of claims 11-14 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of WIPO Patent Publication WO 01/17219 A1 ("Hjartarson") and/or U.S.

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Patent 7,164,694 ("Nodoushani"). Each of these rejections is respectfully traversed as moot in view of the present amendments to claim 1.

As stated above, claim 1, from one of which each of claims 11-14 ultimately depends, states, *inter alia*, yet the applied portions of Hjartarson do not teach, "the line card adapted to utilize an enhanced mode, the enhanced mode adapted to use a codec specified in G.722". For at least these reasons, reconsideration and withdrawal of each rejection of each of claims 2-18, each of which ultimately depends from claim 1, is respectfully requested.

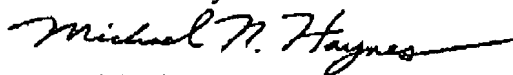
CONCLUSION

It is respectfully submitted that the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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